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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,421	07/30/2001	Akira Suyama	01450/HG	6390

7590 12/03/2001
Frishauf, Holtz, Goodman,
Langer & Chick, P.C.
767 Third Avenue - 25th Floor
New York, NY 10017-2023

EXAMINER

MAHATAN, CHANNING

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 12/03/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,421

Applicant(s)

SUYAMA, AKIRA

Examiner

Channing S Mahatan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

ART UNIT DESIGNATION

The Group and/or Art Unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence regarding this application should be directed to Group Art Unit 1631.

Election/Restrictions

Applicant is required to elect one (1) specie from each of the two (2) specie election requirements

FIRST SPECIE ELECTION REQUIREMENT

This application contains claims directed to the following patentably distinct species of the claimed invention: First and Second embodiments in the specification on pages 6-9.

I. First Embodiment: Claims 1-10 and 12

II. Second Embodiment: Claims 1-11

I. (p.6-7) Provides for screening oligo nucleic acids by a hybridization-based method. II. (p.7-9) Provides for screening oligo nucleic acids by a computer-based method. The above embodiments are considered distinct, establishing a separate classification (First Embodiment classified in class 435, subclass 6. Second Embodiment classified in class 702, subclass 20) and a different field of search. Therefore, species election is required.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-10 are generic.

SECOND SPECIE ELECTION REQUIREMENT

This application contains claims directed to the following patentably distinct species of the claimed invention: Claims 6 and 7.

- I. \underline{n} is 2; Claim 6
- II. \underline{n} is 3; Claim 6
- III. \underline{n} is 4; Claim 6
- IV. \underline{n} is 5; Claim 7
- V. \underline{n} is 6; Claim 7
- VI. \underline{n} is 7; Claim 7
- VII. \underline{n} is more than 7, Claim 6

I. For $n=2$; bases for obtaining frequencies are 16. II. For $n=3$; bases for obtaining frequencies are 64. III. For $n=4$; bases for obtaining frequencies are 256. IV. For $n=5$; bases for obtaining frequencies are 1024. V. For $n=6$; bases for obtaining frequencies are 4096. VI. For $n=7$; bases for obtaining frequencies are 16384. VII. For n more than 7; bases for obtaining frequencies are calculated by 4^n . The \underline{n} value "...enables the calculations to be performed at a practical processing speed" (p.8, lines 12-13). Applicant provides an example utilizing a 7-tuple unit (p.12-15), the \underline{n} -tuple unit is used in the calculation as the denominator for the occurrence frequency. Applicant states "the lower the occurrence frequency the higher the specificity" (p.15, lines 6-9), therefore each \underline{n} value would alter specificity. Hence, a higher occurrence frequency caused by lower \underline{n} values would reduce said specificity. The reduced specificity would reduce the significant selectivity as recited by Pesole et al (p.114, column 2). The above species are considered distinct on the basis of the calculated occurrence frequency values used to

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determine the specificity, establishing a separate status in the art and a different field of search.

Therefore, the above species election is required.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-6 and 8-12 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

EXAMINER INFORMATION

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located

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in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Channing S Mahatan whose telephone number is (703) 308-2380. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Pauline Farrier, whose telephone number is (703) 305-3550 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

Date: *November 29, 2001*

Examiner Initials: *CSM*

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER